

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed October 1, 2008. At the time of the Office Action, Claims 1-28 were pending in the Application and stand rejected. Applicant amends several Independent Claims without prejudice or disclaimer. The amendments to these claims are not the result of any Prior Art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

Claims 1-2, 7-9, 14-15, and 20-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,457,061 issued to Bal et al. (hereinafter "Bal"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each element as set forth in the claim is either found, expressly or inherently described, in a single prior art reference.<sup>1</sup> In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."<sup>2</sup> In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>3</sup> Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>4</sup>

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

<sup>3</sup> MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

<sup>4</sup> MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. and Inter. 1990) (*emphasis in original*)).

Independent Claim 1, as amended, recites (inter alia) "...the providing comprises maintaining a single table for both the forwarding information and the NAT information such that ***the information can be retrieved in the single search operation***, and wherein the table is stored in a content addressable memory (CAM) indexed by a source address and a destination address that are provided as a key in the CAM."

No reference of record, including *Bal*, offers an architecture in which these activities occur. First, *Bal* does not explain how a single memory access would occur in its configuration. If in fact the storage of *Bal* would store some of the information outlined in Independent Claim 1, it is unclear as to how this information would be organized, how it could be subsequently accessed, how it is categorized, how it is filed for future retrieval, etc. In no event is there any disclosure in *Bal* for a single search operation. Second, *Bal* fails to offer any type of CAM element, as is outlined by Independent Claim 1, and the Examiner readily concedes this point. Turning to the Examiner's other reference, *Sloane*, this reference makes a benign overture about a CAM, but hardly in the context of a single search operation: much less a CAM that specifies how a table would be stored and indexed by a source address and a destination address. Finally, no such storage in *Sloane* offers the key as outlined by Independent Claim 1. These important limitations are provided for in Independent Claim 1, but no reference of record includes such elements. Applicant has reviewed *Bal* and *Sloane* in their respective entireties and finds nothing that would be relevant to such operations.

For at least these reasons, Independent Claim 1 is allowable over the cited reference. The other Independent Claims recite limitations similar, but not identical, to these and therefore would be allowable using a similar rationale. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Section 103 Rejection

Claims 3-4, 10-11, 16-17, and 22-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bal* in view of U.S. Patent No. 6,912,223 issued to Sloane (hereinafter "*Sloane*"). Claims 5-6, 12-13, 18-19, and 24-25 stand rejected as being unpatentable over *Bal* in view of U.S. Patent No. 6,888,837 issued to Cunningham (hereinafter "*Cunningham*"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>5</sup>

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each claim limitation of the Independent Claims. This has been evaluated extensively above in the §102 analysis.

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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<sup>5</sup> See M.P.E.P. §2142-43.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

The Request for Continued Examination \$810 large entity fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account No. 50-4889 authorization. It is believed that no other fee is due at this time. If this is incorrect, please apply any other charges or credits to deposit account 50-4889 and reference CSCO-006 (CPOL 78927).

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at (214) 823-1241.

Respectfully submitted,

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Date: March 30, 2009

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